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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEA, PHILIP J

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,435

Applicant(s)

OFFER, GERO

Examiner

Philip J Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/5/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/5/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-25 have been examined.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 00114333.8, filed on 7/4/2000.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

The information disclosure statement (IDS) submitted was filed after the mailing date of the 7/5/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description:

- Note page 6, line 29, "AD".

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37

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CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 2 objected to because of the following informalities:

- Note line 12, "transmitted part" is apparently transmitting part.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the offered" in lines 11 and 12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 2, 14, 15, 21, and 22 rejected under 35 U.S.C. 102(b) as being anticipated by Shah (U.S. 6,029,065).

As per claims 1 and 21, Shah discloses a system, as claimed, comprising:

- a server for interrogating hardware and software configurations of a plurality of terminal devices having a software transmitting part for loading software and data that is customized to the detected terminal devices (column 3, lines 25-40);
- a plurality of terminal devices for transmitting configuration code to central server in response to interrogation (column 7, lines 24-27), also for storing software (column 7, lines 30-35), these happening at certain times (column 6, lines 39-49); and
- interactive specifying of a charging mode for software (column 8, lines 31-41).

In considering claim 21, Shah further discloses a terminal device displaying a charging mode for selected software (columns 8 and 9, lines 65-67 and 1-5 respectively).

As per claims 2 and 22, Shah discloses a system, as claimed, comprising:

- the server offering software from a stored addressable memory; and
- an offer display in the terminal devices for requesting software from the server and accepting or rejecting the software (see Fig. 2 ad column 9, lines 54-61).

While not expressly stated, Shah inherently discloses a memory for offering software. It is implied that the software residing on the server taught by Shah has a storage unit of different software relating to different configurations in order to service different configurations of terminal devices.

As per claim 14, Shah discloses a telecommunications network, as claimed, where the software that is downloaded includes update software for updating software stocks that are stored in the terminal devices (column 8, lines 36-40).

As per claim 15, Shah discloses a method of operating a telecommunication network, as claimed, comprising steps of:

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- interrogating current software and hardware configurations of terminal devices (column 3, lines 25-40);
- transmitting configuration from terminal device to server (column 7, lines 24-27);
- serving sending offer information to terminal device (Fig. 2 and column 9, lines 54-61);
and
- displaying offer information in terminal device, and a request or reject signal from terminal device (Fig. 2 and column 9, lines 54-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Shah as applied to claim 2 above.

As per claims 3 and 17, although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose a filtering method based on previously rejected software by the terminal device. However, it would have been obvious to a person having ordinary skill in the art to stop offering software, which the terminal device has rejected. The desirability and advantages of having such a filtering means would be for the convenience of the user since the user would not have to continually decline the same software they do not want, analogous to a software system for allowing a user to stop checking for software updates by checking a box.

As per claim 4, Shah discloses a telecommunication network, as claimed, comprising:

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- a charging mode for one of the offered software or data, charging mode transmitting part in the server, charging mode display, and charging mode confirmation (column 8 to column 9, lines 65-67 and 1-5, where the charging mode is considered the toll, and the transmitting part considered the base station sending a message).

While not expressly stated, Shah implies that the server included a memory storage area for implementing the charge mode offering suitable for different terminal devices and their configurations.

Claims 5, 6, 16, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Shah as applied to claims 1, 15, and 21 above, and further in view of Chen et al. (U.S. 5,797,016).

Although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose a system where software can be stored and transferred to and from the server and terminal device. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Chen et al.

In an analogous art, Chen et al. discloses a system with a backup server for storing files or current software configurations (column 3, lines 32-34) from a terminal device (column 4, lines 39-43, where files can also be transmitted from the server to the terminal device [column 2, lines 63-67]), as claimed above.

Given the teaching of Chen et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing a server that can store files from terminal devices, such as disclosed by Chen et al., in order to backup current software configurations incase new installations are not successful, the old software can be restored (column 3, lines 32-34).

In considering claim 6, Chen et al. further discloses a conditional update (column 4, lines 37-43, where creation of the back job is considered conditional on the part of the administrator).

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Claims 7, 12, 13, and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Shah as applied to claims 1 and 21 above, and further in view of Valentine et al. (U.S. 6,018,654).

As per claims 7 and 23 although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose network-specific signaling parts on the basis of a SIM card. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Valentine et al. (U.S. 6,018,654).

In an analogous art, Valentine et al. disclose a system with a server with a transmitting part for transmitting software to mobile devices [Figure 3, (170, 20)] using signaling parts on the basis of a SIM card (column 3, lines 7-12). Given the teaching of Valentine et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing signaling parts on the basis of a SIM card, such as disclosed by Valentine et al., in order to interactively download software (see Fig. 4, and columns 4, lines 15-27).

As per claim 12, although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose software for implementing non-network-bound auxiliary functions. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Valentine et al.

Valentine et al. disclose a system with a server with a transmitting part for transmitting software to mobile devices [Figure 3, (170, 20)] where the software being transmitted is non-network bound (column 1, lines 44-52, where tone data is considered non-network bound). Given the teaching of Valentine et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing software for implementing non-network-bound functions such as ring tones, such as disclosed by Valentine et al., in order to provide users with entertainment or, in the case of ring tones, help them determine the caller without picking up the phone (column 1, lines 29-38).

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As per claim 13, it would have been obvious to a person having ordinary skill in the art to offer software for implementing auxiliary services, since the type of software is simply a choice left up to the designer. The desirability and advantages of implementing auxiliary services would be for conveniently allowing the user to connect to the Internet using well-known applications such as a web browser or IM chat client.

Claims 8 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Shah as applied to claims 1 and 15 above, and further in view of Pepe et al. (U.S. 5,742,668). Although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose a central server, which acts as an intermediate station between two terminal devices for loading data from one terminal device to another. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Pepe et al.

In an analogous art, Pepe et al. disclose a telecommunications network with a central server used for transmitting data between devices (column 13, lines 29-39). Devices include cellular phones, PDAs, and email from workstations [Figure 1, (32, 30, 22)]. Given the teaching of Pepe et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing a central server to act as an intermediate station to load software between devices, such as disclosed by Pepe et al., in order to communicate messages between devices from anywhere at anytime (column 1, lines 42-43).

Claims 9-11, 19, 20, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Shah as applied to claims 1, 15, and 21 above, and further in view of Shear (U.S. 4,977,594).

As per claims 9 and 19, although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose determining the validity of software and usage authorization. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Shear.

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In an analogous art, Shear discloses a system for distributing data with a validation storage unit for storing authorization data, and determining the validity of data of terminal devices (column 14, lines 29-36).

Given the teaching of Shear, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing the validation storage unit, such as disclosed by Shear, in order to bill the user according to the amount of resources used (column 3, lines 52-59). In a software/data distributing environment where resources are not free, it would be advantageous for the supplier of the software/data to keep track of the software being deployed in order to charge the appropriate amount to the user.

As per claims 10 and 20, although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose terminal devices with application counter elements, and a server including an arithmetic evaluation unit. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Shear.

In an analogous art, Shear discloses a system for distributing data to terminal devices with a use-based charging mode to keep track of the amount of usage by a terminal device where the terminal device has a counter, and server has an evaluation unit (column 13, lines 47-60). Given the teaching of Shear, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing a server with an evaluation unit and terminal devices with counters, such as disclosed by Shear, in order to bill the user according to the amount of resources used (column 3, lines 52-59). In a software/data distributing environment where resources are allocated on a subscriber basis, it would be advantageous for the supplier to keep track of the usage to appropriately bill the users.

As per claims 11 and 25, although Shah discloses substantial features of the claimed invention (discussed above), he fails to directly disclose a transmission unit used for transmitting messages to the terminal device relating to the application counter status. However, these

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features are well known in the art and would have been an obvious modification of the system disclosed by Shah, as evidenced by Shear.

In an analogous art, Shear discloses a system for distributing data, which includes a transmission unit for displaying application counter status for a terminal device user indicating the usage statistics of the used resources.

Given the teaching of Shear, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Shah by employing a transmission unit used for displaying the application counter status (column 15, lines 33-47), such as disclosed by Shear, in order to bill the user according to the amount he has used the resources (column 3, lines 52-59). Further, Shear does not expressly state that the counter status is displayed to the user through their display. However, it would have been obvious to a person having ordinary skill in the art to show the counter status to the user through their terminal display. The desirability and advantages of providing the counter status information through the users' display would be to easily monitor their usage.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Alazma, Manar et al.	US 6173175
Fawcett, Philip E.	US 5845077
Frye, Russell	US 6047129
Gerszberg, Irwin	US 5297192
Hansson, Lars	US 6023620
Hoffman, Ted L.	US 6622017
Hornbuckle, Gary D.	US 5649187
Hornbuckle, Gary D.	US 5388211
Imamatsu, Ken'ichi	US 6687901

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Marran, Nadine	US 6549770
Nakagawa, Toru et al.	US 5835911
Nodoushani, Paiman et al.	US 6144849
Sakanishi, Yoshiko	US 6678888
Stair, Mark T. et al.	US 5381138
Suzuki, Hideo	US 6230187

Marran, Nadine L. "Over-The-Air Subscriber Device Management Using CDMA Data and WAP."
Proceedings of the 9th Ann Virginia Technical Symposium on Wireless Personal
Communication (1999): 165-174.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Chea whose telephone number is 703-605-1202. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC


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